

UNITED STATES DISTRICT COURT
Northern District of California

San Francisco

BARNES AND NOBLE, INC., et al.,

No. C 11-02709 EMC (LB)

Plaintiffs,

v.

**ORDER GRANTING DEFENDANTS'
MOTION FOR ISSUANCE OF
LETTERS ROGATORY**

LSI CORPORATION, et al.,

[Re: ECF No. 99]

Defendants.

I. INTRODUCTION

Plaintiffs Barnes & Noble, Inc. and barnesandnoble.com LLC (collectively, "B&N") filed the instant action seeking a declaratory judgment of non-infringement and patent invalidity against defendants LSI Corporation and Agere Systems, Inc. (collectively, "Defendants"). Original Complaint, ECF No. 1.¹ Defendants answered B&N's First Amended Complaint and brought counterclaims against B&N for patent infringement. Answer and Counterclaims, ECF No. 62.

On April 10, 2012, Defendants filed a Motion for Issuance of Letters Rogatory. Motion, ECF No. 99. No opposition to it has been filed. *See* N.D. Cal. Civ. L.R. 7-3(a) (providing that an opposition must be served and filed not more than 14 days after a motion is served and filed). Upon consideration of the motion, the letters rogatory submitted with it, and the relevant authority, the

¹ Citations are to the Electronic Case File ("ECF") with pin cites to the electronic page number at the top of the document, not the pages at the bottom.

1 court GRANTS Defendants' motion.²

2 II. BACKGROUND

3 B&N seeks a declaratory judgment that their NOOK™ line of eBook readers (the "Accused
4 Products") does not infringe eleven of Defendants' patents relating to Wi-Fi, 3G, and audio
5 technology. B&N has represented in its briefing in this case that "[i]n large part, the NOOK™
6 functionality that is the subject of this case – functionality related to Wi-Fi, 3G, and audio – is
7 implemented by components called 'chips' that are supplied to [Plaintiffs] by third parties." B&N's
8 Opposition to Motion to Dismiss, ECF No. No. 27, at 14. B&N has stated that these third party
9 manufacturers include Inventec Corporation ("Inventec"). *Id.* In addition, through a physical
10 investigation of the infringing products, Defendants have discovered that one or more of the
11 components relevant to Defendants' infringement claims are made by Jorjin Technologies, Inc.
12 ("Jorjin"). Ranganath Decl., ECF No. 100 at 2, ¶ 2.

13 Defendants believe that to complete their infringement contentions, they need not only the
14 technical documentation about these products and components that is publicly available, but also
15 additional design information that is not publicly available. *Id.*, ¶ 4. Defendants have served
16 discovery on B&N to obtain technical information about the Accused Products, but Defendants
17 represent that B&N has taken the position that it does not have all of the relevant documentation. *Id.*
18 at 2, ¶ 2. Defendants attempted to serve a third party subpoena for documents on Inventec's U.S.
19 affiliate, but that affiliate subsequently certified that it does not have responsive documents within
20 its possession, custody or control, and cannot obtain such documents from its corporate parent. *Id.* ¶
21 5, Ex. B. Defendants further represent that B&N has indicated that Inventec is headquartered in
22 Asia, and corporate records searches carried out by Defendants indicate that Inventec has offices in
23 Taipei, Taiwan. Gilbert Decl., ECF No. 28 at 2-3, ¶ 6; Ranganath Decl., ECF No. 100 at 3, ¶ 8, Ex.
24 D. In addition, Defendants are unable to serve a subpoena on Jorjin because it has no U.S. offices or
25 subsidiaries. Ranganath Decl., ECF No. 100 at 3, ¶ 7, Ex. C. Therefore, Defendants believe that

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28 ² Pursuant to this District's Civil Local Rule 7-1(b), the court finds this matter suitable for
determination without oral argument and vacates the May 17, 2012 hearing.

1 they are unable to secure the information it requires from these parties through traditional discovery
2 means. Motion, ECF No. 99 at 3.

3 III. LEGAL STANDARD

4 A letter rogatory is a formal written request sent by a court to a foreign court asking that the
5 testimony of a witness residing within that foreign court's jurisdiction be taken pursuant to the
6 direction of that foreign court and transmitted to the requesting court for use in a pending action.
7 *Marroquin-Manriquez v. I.N.S.*, 699 F.2d 129 (3rd Cir. 1983); 8A Charles Alan Wright, Arthur R.
8 Miller & Richard L. Marcus, Federal Practice and Procedure § 2083 (3d ed. 2010). A letter rogatory
9 can also include requests for the production of documents. See *United States v. Reagan*, 453 F.2d
10 165, 168 (6th Cir. 1971) (affirming district court's issuance of letters rogatory seeking documents
11 from investigation conducted by German authorities). Federal Rule of Civil Procedure 28(b)(2)
12 provides that a deposition may be taken in a foreign country "under a letter of request, whether or
13 not captioned a 'letter rogatory.'"

14 A court has inherent authority to issue letters rogatory. See *Reagan*, 453 F.2d at 172; *United*
15 *States v. Staples*, 256 F.2d 290, 292 (9th Cir. 1958). 28 U.S.C. § 1781 also implicitly provides
16 federal courts with authority to issue letters rogatory. 28 U.S.C. § 1781(a)(2).³ Whether to issue
17 such a letter is a matter of discretion for the court. See *United States v. Mason*, 919 F.2d 139, 1990
18 WL 185894, 3 (4th Cir. 1990) (unpublished per curiam decision). When determining whether to
19 exercise its discretion, a court will generally not weigh the evidence sought from the discovery
20 request nor will it attempt to predict whether that evidence will actually be obtained. *Asis Internet*
21 *Services v. Optin Global, Inc.*, No. C-05-05124 JCS, 2007 WL 1880369, at *3 (N.D. Cal. Jun 29,
22 2007) (citing *Sec. Ins. Co. of Hartford v. Trustmark Ins. Co.*, 218 F.R.D. 24, 27 (D. Conn. 2003);
23 *DBMS Consultants Ltd. v. Computer Assocs. Int'l, Inc.*, 131 F.R.D. 367, 369 (D. Mass. 1990); *B & L*
24 *Drilling Elecs. v. Totco*, 87 F.R.D. 543, 545 (W.D. Okla. 1978)). A court's decision whether to

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26 ³ 28 U.S.C. § 1781 provides the State Department with the power "to receive a letter rogatory
27 issued, or request made, by a tribunal in the United States, to transmit it to the foreign or
28 international tribunal, officer, or agency to whom it is addressed, and to receive and return it after
execution." 28 U.S.C. § 1781(a)(2).

1 issue a letter rogatory, though, does require an application of Rule 28(b) in light of the scope of
 2 discovery provided for by the Federal Rules of Civil Procedure. *See Evanston Ins. Co. v. OEA, Inc.*,
 3 No. CIV S-02-1505 DFL PAN, 2006 WL 1652315, at* 2 (stating that Rule 28(b) “must be read
 4 together” with Rule 26(c) in determining whether to issue letter rogatory); *see also DBMS*
 5 *Consultants Ltd.*, 131 F.R.D. at 369-70; *B & L Drilling Elecs.*, 87 F.R.D. at 545.

6 IV. DISCUSSION

7 The discovery Defendants’ request from Inventec and Jorjin is relevant and discoverable under
 8 the standard set forth in Rule 26 because, as described above, it may provide information about the
 9 design, operation and manufacture relating to the material functionalities of the Accused Products
 10 that is neither publicly available nor available via party discovery. *See Fed. R. Civ. P. 26(b).*⁴
 11 Because Inventec and Jorjin are business entities incorporated, headquartered and doing business in
 12 Taiwan, *see Ranganath Decl.*, ECF No. 100, Exs. C, D, and all other efforts to obtain the discovery
 13 have failed, *see id.* at 2-3, ¶¶ 5, 7, the court finds that letters rogatory are necessary and appropriate
 14 mechanisms to request the desired discovery.

15 V. CONCLUSION

16 Defendants Motion for Issuance of Letters Rogatory is GRANTED. The court will sign and
 17 affix its seal to each of the letters rogatory submitted and return the letters with original signatures
 18 and seals to Defendants’ counsel for forwarding to the United States Department of State.

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21 ⁴ Subject to the limitations imposed by subsection (b)(2)(C), under Rule 26, “[p]arties may
 22 obtain discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense .
 23 . . .” Fed. R. Civ. P. 26(b)(1). “Relevant information need not be admissible at the trial if the
 24 discovery appears reasonably calculated to lead to the discovery of admissible evidence.” *Id.*
 25 However, “[o]n motion or on its own, the court must limit the frequency or extent of discovery
 26 otherwise allowed by these rules or by local rule if it determines that: (i) the discovery sought is
 27 unreasonably cumulative or duplicative, or can be obtained from some other source that is more
 28 convenient, less burdensome, or less expensive; (ii) the party seeking discovery has had ample
 opportunity to obtain the information by discovery in the action; or (iii) the burden or expense of the
 proposed discovery outweighs its likely benefit, considering the needs of the case, the amount in
 controversy, the parties’ resources, the importance of the issues at stake in the action, and the
 importance of the discovery in resolving the issues.” Fed. R. Civ. P. 26(b)(2)(C).

1 **IT IS SO ORDERED.**

2 Dated: April 27, 2012



3 LAUREL BEELER
4 United States Magistrate Judge
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